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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/448,613

Applicant(s)

MCCRAY JR ET AL.

Examiner

Richard Schnizer

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-70 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-37, 48-52, and 70, drawn to methods of increasing the susceptibility of epithelial cells to viral infection in vitro, classified in class 435, subclass 456.
- II. Claims 38-47, 68 and 69 drawn to composition for aerosol or topical delivery, classified in class 424, subclass 1.13.

The inventions are distinct, each from the other because of the following reasons.

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition of group II could be used to deliver a virus to any cell. In contrast, the method of group I requires delivery to epithelial cells.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

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Election of Species

Claim 26 is generic to a plurality of disclosed patentably distinct species comprising a retrovirus, an adenovirus, a parvovirus, a papovavirus, a paramyxovirus, and a vaccinia virus. Lentiviruses and adeno-associated viruses are recited as species in the claim but are not included as electable species, because the claim also recites a retroviruses and a parvovirus. Lentiviruses and adeno-associated are species of retroviruses and parvoviruses, respectively. A proper Markush group does not recite members which are related as genus and species. The species available for election have been limited accordingly. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 29 and 64 are generic to a plurality of disclosed patentably distinct species comprising a tumor suppressor, a cytokine, an enzyme, a toxin, a membrane channel, a transcription factor, and a single chain antibody. It is noted that the claim recites additional species including a growth factor, a hormone, an enzyme, and a transcription factor. However, a cytokine is considered to be a species of growth factor, which is in turn a species of hormone. Similarly, apoptosis inducers can be either transcription factors or enzymes. A proper Markush group does not recite members which are related as genus and species. The species available for election have been limited accordingly. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claim 33 is generic to a plurality of disclosed patentably distinct species comprising lung cancer, tracheal cancer, asthma, surfactant protein B deficiency, alpha-1-antitrypsin deficiency,

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and cystic fibrosis. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

This application contains claims directed to the following patentably distinct species of the claimed invention of groups I and II: permeabilizing agents including a hypotonic solution alone; an ion chelator alone; the combination of a hypotonic solution and an ion chelator (see claims 68 and 69); a cationic peptide; an occludin peptide; a cytoskeletal disruption agent; ether; glycerol; a neurotransmitter; FCCP; an oxidant; a mediator of inflammation; and a cytokine.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-67, 69 and 70 are generic.

In summary, Applicant is required to elect a single disclosed permeabilizing agent, a single disclosed vector, a single disclosed gene, and a single disclosed disease for prosecution on the merits.

Applicant is advised that a reply to this requirement must include an identification of the species that are elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

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of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 103-306-5441. The examiner can normally be reached Monday through Friday between the hours of 6:20 AM and 3:50 PM. The examiner is off on alternate Fridays, but is usually in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, can be reached at 703-305-6608. The FAX numbers for art unit 1632 are 703-308-4242, and 703-305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to the Patent Analyst Patsy Zimmerman whose telephone number is 703-308-8338.

Richard Schnizer, Ph.D.

Scott D. Pribe
SCOTT D. PRIEBE, PH.D.
PRIMARY EXAMINER